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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	10414.4	2969
21999	7590	06/16/2004		
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER	BAHTA, ABRAHAM
			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,989	WALKER, ROLAND N.	
	Examiner	Art Unit	
	Abraham Bahta	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 May 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) 1-10, 16-20, 25 and 31-34 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-15, 21-24 and 26-30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claims 1-34 are pending in this application. Claims 1-10 and 16-20 are withdrawn from further consideration as being drawn to a non-elected invention.

Further, the amendment filed 03/22/04 indicates that claims 25 and 31-34 (previously examined) are now withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (USP 6,172,328) or Skonecki (USP 5,305,550).

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

Jones and Skonecki do not require identical images on a number of flowers; however, Jones and Skonecki teach the concept of providing an image, drawing or personalized message on the flower petal or rose. It is notoriously well known to use a stamp to provide identical images on materials and it would have been obvious to the skilled artisan to use a stamp or pad if a series of identical images is desired. The limitation such that the image is "pad-printed" has been considered; however, the fact remains that both references teach the concept of providing a mark or inscription on an organic product such as a flower. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct over the product of the prior art. See *In re Brown*, 173 USPQ 685, and *In re Fessmann*, 180 USPQ 324.

Regarding claim 15, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones '328 or Skonecki '550.

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44. Therefore, it is the position of the Examiner that the flower is in an undamaged form.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38. Further, Skonecki at col. 2, lines 19-24 teaches when the Pilot pen is used to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and that no smearing, smudging or other unwanted marks are left on the petal surface.

Regarding the limitation such that the flower may be provided a "repeatable image", since Jones and Skonecki teach the concept of providing a marking, inscription on a flower, and that the marking may be a message of greeting, expression, identification, information, communication, inscription and advertisement, repeating the

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same message, expression, identification, information is inherent. It is the Examiner position that “repeatable image” does not necessary mean “identical image”.

Regarding claims 26, 28-30, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See col. 3, lines 21-38. In addition, Skonecki teaches the inscription may be personalized message such as the word “congratulations”.

Regarding claim 27, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Response to applicant's arguments

With respect to Jones the applicant argues that the reference does not teach a group of flowers each having placed thereon an overlaid identical pad-printed image wherein each of the group of flowers is in a natural undamaged configuration and that instead, Jones teaches a group of flower that have etched, cut or altered surfaces which have been disrupted on their surfaces or have been cut by the laser beam. The Examiner contends that the fact remains that Jones teaches the concept of providing an organic product such as a flower with a marking such as a message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27. Further, the applicant

argues that the reference teaches methods for etching, cutting the surface of a flower, plant cut foliage and that the process Jones does not teach overlaying an image onto a group of flowers in a natural undamaged configuration. The Examiner disagrees. Jones teaches the leaves may be provided with a design by inserting an opaque metal stencil machined with the desired design and focusing optics between a stationary laser beam and foliage and that the leaves may be used in floral arrangement or potted plant arrangements to convey a greeting such as "Happy valentines Day". Jones teaches the designs may be provided using stencils. See col. 1, lines 54-65 and col. 4, lines 26-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44.

With respect to Jones, the applicant argues that the reference teaches methods for etching, cutting the surface of a flower, plant cut foliage and that the process Jones does not teach overlaying an image onto a group of flowers in a natural undamaged configuration. The Examiner disagrees. Jones teaches the leaves may be provided with a design by inserting an opaque metal stencil machined with the desired design and focusing optics between a stationary laser beam and foliage and that the leaves may be used in floral arrangement or potted plant arrangements to convey a greeting such as "Happy valentines Day". Jones teaches the designs may be provided using stencils. See col. 1, lines 54-65 and col. 4, lines 26-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize

and resipre even when the design is provided on the surface of the flower. See col. 3, lines 38-44.

The applicant argues that Skonecki does not teach a group of flowers each having placed thereon overlaid identical pad-printed image or in that each of the flowers in the group of flowers as in an undamaged natural configuration and that Skonecki's process is performed by a human, there is a chance that the Skonecki process can result in more than minimal pressure being applied thereby damaging the petal. The Examiner contends that the claims of the instantly claimed invention are drawn to an article and not to a process. Further, the Examiner contends that although Skonecki uses a pen to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and as a result, no smearing, smudging or other unwanted marks are left on the petal surface. See Skonecki col. 2, lines 19-24. The applicant contends that the flower of the present claimed invention is "undamaged" whereas the rose of Skonecki '550 is indented, causing surface cellular damage and faster withering. The Examiner disagrees. Skonecki at col. 2, lines 19-24 teaches when the Pilot pen is used to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and that no smearing, smudging or other unwanted marks are left on the petal surface.

Any inquiry concerning this communication should be directed to Abraham Bahta whose telephone number is (571) 272-1532. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

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If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta

06/09/04



DEBORAH JONES
SUPERVISORY PATENT EXAMINER